

Application No. 10/765,263  
Amendment dated December 29, 2005  
Reply to Office Action of October 3, 2005

### **REMARKS**

Claims 1-20 remain pending in the application and claims 1, 3, 5, 7, 8, 10-12, 14, 15, 17, 18 and 20 stand rejected. Claims 2, 4, 6, 9, 13, 16 and 19 were objected to for depending from rejected base claims, and claims 21-27 were withdrawn in view of a restriction requirement. Claims 21-27 have been canceled, without prejudice, by this amendment.

Applicant would like to thank the Examiner, Chi Q. Nguyen, and the Examiner's supervisor, Carl Friedman, for the personal interview with Applicant's representative David W. Dorton, conducted December 13, 2005. During the interview, claim 1 was discussed with respect to the references of record. In particular, Applicant's representative asserted that neither U.S. Patent No. 5,613,339 to Pollock, nor any other reference of record teaches or suggests the invention recited in claim 1, as discussed more fully below. Applicant respectfully requests reconsideration in view of the personal interview and the following remarks.

### **Election of Claims**

Claims 1-27 are subject to restriction, wherein the Examiner has identified the following patentably distinct inventions:

- I. Claims 1-20 (apparatus claims)
- II. Claims 21-27 (method claims)

Applicant hereby affirms the election of claims 1-20 for examination on the merits, as made by Applicant's representative during a telephone call with the Examiner

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on September 26, 2005. Claims 21-27 are hereby canceled, without prejudice and reserving the right to pursue these canceled claims in a subsequent divisional application.

**Claims Rejected Under 35 U.S.C. §102**

Claims 1, 5, 7, 11, 12, 14 and 15 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,613,339 to Pollock. Claims 1, 11 and 14 are the only independent claims of this rejected group. Claim 1 is directed to a module for a utility trenching and sidewalk system including side walls, a bottom wall, and "at least one cavity formed in said side walls and said bottom wall for receiving wet, poured concrete." Claim 11 is directed to a kit for forming a utility trenching and sidewalk system, and claim 14 is directed to a utility trenching and sidewalk system. Each of claims 11 and 14 recite the same language as claim 1.

To anticipate a claim under §102, the reference must disclose each and every element recited in the claim. Applicant respectfully traverses the rejections of claims 1, 11 and 14 because Pollock '339 does not teach or suggest "at least one cavity formed in said side walls and said bottom wall," as recited in claims 1, 11 and 14 (emphasis added). Rather, Pollock '339 is directed to an extruded plank for use in constructing decks. In FIG. 2, Pollock '339 discloses an extruded structure having channels bounded by side flanges 13a, 13b; side webs 19a, 19b; and base web 11. Pollock '339, however, does not teach or suggest a cavity formed in the bottom wall (base web 11), as required by claims 1, 11 and 14. During the personal interview on December 13, 2005, the Examiner agreed that Pollock '339 did not teach or suggest the claimed

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structure. Accordingly, Applicant respectfully requests that the rejections of claims 1, 11 and 14 under §102 be withdrawn.

Claims 5 and 7 depend from independent claim 1, claim 12 depends from independent claim 11, and claim 15 depends from independent claim 14. Accordingly, claims 5, 7, 12 and 15 are each in condition for allowance for at least the reasons stated above for respective independent claims 1, 11 and 14, and Applicant respectfully requests that the rejections of claims 5, 7, 12 and 15 over Pollock '339 be withdrawn.

**Claims Rejected Under 35 U.S.C. §103**

Claims 8, 10, 17 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pollock '339. Claims 3 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pollock '339 in view of U.S. Patent No. 4,324,078 to Gray. Claims 3, 8 and 10 each depend from independent claim 1, and claims 17, 18 and 20 each depend from independent claim 14.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings to arrive at the claimed invention; there must be a reasonable expectation of success; and the reference(s) must teach or suggest all of the claimed limitations. As discussed above, Pollock '339 does not teach or suggest each and every element of claims 1, 11 and 14, as agreed by the Examiner in the personal interview. Accordingly, each of claims 3, 8, 10, 17, 18 and 20, which depend therefrom, are in condition for allowance for at least the reasons stated above for their respective independent claims 1, 11 and 14. Specifically, Pollock '339 does not teach or suggest "at least one cavity formed in said

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side walls and said bottom wall," as recited in claims 1, 11 and 14 and discussed above. Neither Gray '078, nor any other reference of record teaches or suggests a modification of Pollock '339 that results in the claimed invention. For at least these reasons, Applicant respectfully requests that rejections of claims 3, 8, 10, 17, 18 and 20 be withdrawn.

Applicant further traverses the rejections of claims 10 and 17 because there is no teaching whatsoever in any of the references of record to include "at least one reference line disposed across the module between said outer side walls and oriented to facilitate subdividing the module into fractional pieces," as recited in claim 10, or a utility trenching and sidewalk system "wherein at least one of said modular units is divided into fractional pieces and aligned with at least one adjacent modular unit to change the direction of said conduit," as recited in claim 17.

#### **Allowable Subject Matter**

Claims 2, 4, 6, 9, 13, 16 and 19 were objected to for depending from rejected base claims, but were indicated to be allowable if rewritten in independent form. Applicant thanks the Examiner for recognizing the allowable subject matter of these claims. However, Applicant believes that the need for rewriting these claims in independent form is moot in view of the remarks above.

#### **Conclusion**

In view of the foregoing amendments to the claims and the remarks set forth herein, Applicant respectfully believes this case is in condition for allowance, and

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respectfully requests allowance of the pending claims. If the Examiner believes any issue requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter maybe promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicant is of the opinion that no fee is due as a result of this amendment. If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

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